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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,051	06/20/2001	Yoshiki Kawaoka	3562-0117P	2692

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EXAMINER
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VILLECCO, JOHN M

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/884,051	<b>Applicant(s)</b> KAWAOKA ET AL.	
	<b>Examiner</b> John M. Villecco	<b>Art Unit</b> 2612	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 3,12-19,22 and 30-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,10,11,20,21,23,28,29,38,39,44-47 and 52-55 is/are rejected.
- 7) ☒ Claim(s) 5-9,24-27,40-43 and 48-51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2005 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed December 15, 2005 have been fully considered but they are not persuasive.
3. Firstly, applicant's amendment to claims 40-42 and 48-50 have overcome the 112, 1<sup>st</sup> paragraph rejection from the previous office action.
4. Regarding claims 1 and 20, applicant has amended the claims to include the limitation of the transmitting the photo images over a transmission medium having a predetermined configuration and predetermined transmission settings. Applicant argues on page 21 of the applicant's amendment that Fukushima fails to teach that the transmission section does not have a predetermined configuration and predetermined transmission settings. The examiner disagrees with this assertion. Firstly, the word "predetermined" is an extremely broad phrase when used without a time reference. The claims only state that the transmission section has "predetermined configuration and predetermined transmission settings". Are these settings and configuration

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predetermined immediately before transmission or when the digital camera was manufactured?

In both instances the examiner still believes that Fukushima can be read on the claim invention.

Fukushima discloses that the images can be transferred using a dedicated transmission cable (2090) or using the modems (2060 and 2070). These two transmission mediums are interpreted to have a predetermined configuration. Additionally, it is inherent that both of these transmission mediums will be controlled by predetermined settings within both the camera (2100) and the external equipment (2200). Thus, the transmission section has predetermined configuration and predetermined configuration settings because there are only two known transmission mediums and furthermore, the configuration would be set up (i.e. predetermined) before transmission.

5. For this reason, the art rejections from the previous office action will be repeated.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1, 10, 20, 28, 38, 46, 54, and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukushima et al. (U.S. Patent No. 6,253,023).**

8. Regarding *claim 1*, Fukushima discloses a camera capable of sending an image over a transmission network after checking on the transmission conditions. More specifically,

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Fukushima discloses a digital camera (2100) that includes an interface (2010), which is interpreted to be the transmission section, and a system controlling circuit (2024), which is interpreted to be the transmission control unit. The system controlling circuit (2024) operates to capture images and control the transfer of images out of the camera (2100). The camera operates to capture an image (S2005) and after the capture of the image is complete (col. 32, lines 5-6) determination is made whether or not to transmit an image. A number of transmission conditions are checked before the image transmission is carried out. For instance, the transmission means is detected, the number of transmission means is detected, and the optimal transmission means is detected. All of these conditions are interpreted to be the transmission allowance conditions. Inherently, the system controlling circuit (2024) operates to check if each of the transmission allowance conditions have been met. If each of the transmission allowance conditions has been evaluated, then the system operates to transmit the images. Fukushima discloses that the images can be transferred using a dedicated transmission cable (2090) or using the modems (2060 and 2070). These two transmission mediums are interpreted to have a predetermined configuration. Additionally, it is inherent that both of these transmission mediums will be controlled by predetermined settings within both the camera (2100) and the external equipment (2200). Thus, the transmission section has predetermined configuration and predetermined configuration settings because there are only two known transmission mediums and furthermore, the configuration would be set up (i.e. predetermined) before transmission.

9. As for **claim 10**, Fukushima discloses a transmission switch (2038) and means for selecting an image to be transferred (col. 32, lines 51-53). This information is sent to the system

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controlling circuit (2024) indicating that the image is to be transferred to the external device (2200).

10. **Claim 20** is considered a method claim corresponding to claim 1. Please see the discussion of claim 1 above.

11. **Claim 28** is considered a method claim corresponding to claim 10. Please see the discussion of claim 10 above.

12. Regarding **claim 38**, Fukushima discloses that a plurality of factors are considered before image transfer, such as, transmission means, the number of transmission means, and the optimal transmission means. See Figures 16-18.

13. With regard to **claim 46**, Fukushima discloses that the method of transmission takes place in a camera (2100).

14. Regarding **claim 54**, as mentioned above, Fukushima discloses that a plurality of different transmission conditions are checked, including the transmission means, the number of transmission means, and the optimal transmission means. See Figures 16-18. When each of these conditions has been checked and satisfied, the image is transmitted to the external device (S2016).

15. **Claim 55** is considered a method claim corresponding to claim 54. Please see the discussion of claim 54 above.

### ***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. **Claims 2 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Fukushima in view of Tamura et al. (U.S. Application Publ. No. 2004/0169730 A1).**

18. Regarding *claim 2*, as mentioned above in the discussion of claim 54, Fukushima discloses all of the limitations of the parent claim. However, Fukushima fails to explicitly disclose a battery, wherein the storage level of the battery is used a predetermined transmission allowance condition. Tamura, on the other hand, discloses camera that checks the battery level of the camera before transmitting images in order to determine if enough battery power is left for a successful transmission. More specifically, as shown in Figures 9 and 10 and discussed in paragraphs 0197-0201, Tamura discloses determining the number of sheets for transmission, then checking the battery to determine how many sheets can successfully be transmitted. If the number of sheets to be transmitted is more than the number of sheets that can successfully be transmitted using the battery, then transmission of the images does not occur. If the amount of battery is sufficient then the transmission of the images to the printer is allowed. Additionally, Tamura discloses that instead of calculating the number of sheets to be transmitted, the number of bytes to be transmitted can be used. This feature allows for the successful transmission of image data based on the battery power left. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine if the amount of battery left in Fukushima is sufficient for the successful transfer of images to the computer.

19. *Claim 21* is considered a method claim corresponding to claim 2. Please see the discussion of claim 2 above.

20. **Claims 4 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (U.S. Patent No. 6,253,023) in view of Iizuka (Japanese Publ. No. 09-288684 A).**

21. Regarding **claim 4**, as mentioned above in the discussion of claim 54, Fukushima discloses all of the limitations of the parent claim. However, Fukushima fails to explicitly disclose transmitting data depending on a timer. Iizuka, on the other hand, discloses that it is well known in the art to transmit images based on a set schedule. More specifically, Iizuka discloses a method of posting updated images on a website. The system includes image gathering terminals (1a-1d) and an image collection terminal (3). When a timer indicates that it is time to collect images the image collection terminal calls the image gathering terminals and requests images. This feature allows for a continuously updated image stream viewable over a network. Therefore, it would have been obvious to incorporate a system within the camera of Fukushima that transmits images a specified times of the days so that an updated image is continuously presented over a network. An official translation of this reference has been ordered for use in subsequent office actions.

22. **Claim 23** is considered a method claim corresponding to claim 4. Please see the discussion of claim 4 above.

23. **Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima in view of Safai (U.S. Patent No. 6,715,003).**



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24. Regarding *claim 11*, as mentioned above in the discussion of claim 54, Fukushima discloses all of the limitations of the parent claim. However, Fukushima fails to explicitly disclose an addressee registration section for registering a phone number of an addressee for transmitting the photo images. Safai, on the other hand, discloses that it is well known in the art to register the destination information of an image to be transmitted. More specifically, as disclosed in column 8, line 37 to column 9, line 20, a user is able to enter a destination email address or select a destination email address from a list. Additionally, Safai discloses that the address does not have to specifically be an email address. The address can also be a phone number (col. 10, line 54). This feature allows a user to select a destination address to associate with an image that is to be transmitted. Thus, a user can transmit an image to any user who they decide. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow a user to register a phone number of a destination user in the camera of Fukushima so that user has control over who the image data is to be transmitted.

25. *Claim 29* is considered a method claim corresponding to claim 11. Please see the discussion of claim 11 above.

26. **Claims 39 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (U.S. Patent No. 6,253,023) in view of Iizuka (Japanese Publ. No. 09-288684 A) and further in view of Shibata et al. (Japanese Publ. No. 56152368 A).**

27. Regarding *claim 39*, as mentioned above in the discussion of claim 4, the combination of Fukushima and Iizuka discloses all of the limitations of the parent claim. However, neither of the aforementioned references discloses that the predetermined time range is based on a cost of

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transmission. Shibata, on the other hand, discloses that it is well known in the art to delay the transmission of image data until a specific time so that it will be cheaper to transmit the image. See the abstract. More specifically, Shibata teaches sending a facsimile at night when telephone charges are cheap, thus saving money on the image transmission. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to delay the image transmission of Fukushima so that the image is transmitted at a time when the image transmission will be cheapest (e.g. at night) so as to save money.

28. ***Claim 47*** is considered a method claim corresponding to claim 11. Please see the discussion of claim 11 above.

29. **Claims 44, 45, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukushima et al. (U.S. Patent No. 6,253,023).**

30. Regarding ***claim 44***, as mentioned above in the discussion of claim 1, Fukushima discloses all of the limitations of the parent claim. However Fukushima fails to explicitly disclose that the transmission section communicates wirelessly to a wireless communication device. Official Notice is taken as to the fact that it is well known in the art to transmit images wirelessly. Transmitting images wirelessly provides for more mobility for the user and less bulky cameras, due to the reduction of cabling. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the camera of Fukushima communicate wirelessly in order to provide the user with more mobility and less cabling.

31. As for ***claim 45***, as mentioned above in the discussion of claim 1, Fukushima discloses all of the limitations of the parent claim. However Fukushima fails to explicitly disclose that the

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wireless communication device is a cellular telephone. Official Notice is taken as to the fact that it is well known in the art to transmit image wirelessly from a camera to a cellular telephone.

The ability to transfer an image from a camera to cellular telephone enables a user to send images to the wireless telephone for transfer over the cellular network. Thus, it would have been obvious to one of ordinary skill in the art to transfer images from a camera to cellular telephone so that the image can be transferred over the cellular network.

32. **Claim 52** is considered a method claim corresponding to claim 44. Please see the discussion of claim 44 above.

33. **Claim 53** is considered a method claim corresponding to claim 44. Please see the discussion of claim 44 above.

#### ***Allowable Subject Matter***

34. Claims 5-9, 24-27, 40-43, and 48-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

35. The following is a statement of reasons for the indication of allowable subject matter:

Regarding **claims 5 and 24**, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the transmission control unit notifies a user of a period of time to an end of the predetermined time range, based on the time obtained by the time obtaining section.

As for **claims 6 and 25**, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the predetermined transmission

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allowance condition includes a condition when a cost for transmitting the photo images calculated by the data amount-obtaining section is within a predetermined range.

With regard to *claims 9 and 27*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the predetermined transmission allowance condition includes a condition when a remaining time for transmitting said photo images is shorter than a predetermined time, in a case where a cost for a transmission is calculated based on unit communication time.

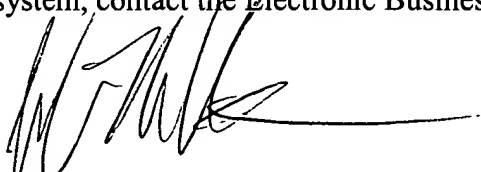
Regarding *claims 43 and 51*, the primary reason for indication of allowable subject matter is that the prior art fails to teach or reasonably suggest that the at least one transmission allowance condition other than the completion of photography includes a time duration required for transmitting said photo images being at or above a predetermined time duration level.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Villecco whose telephone number is (571) 272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'John M. Villecco', with a long horizontal flourish extending to the right.

John M. Villecco  
February 22, 2006